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D E C I S I O N
of 22 March 2000

Case Number: T 0886/95 - 3.3.2

Application Number: 90913758.0

Publication Number: 0491791

IPC: A23L 1/314

Language of the proceedings: EN

Title of invention:
Method for eliminating fat from a ground meat product and apparatus therefor

Applicant:
MARGOLIS, Geoffrey

Opponent:
-

Headword:
Ground meat product/MARGOLIS

Relevant legal provisions:
EPC Art. 111(1), 123(2)

Keyword:
"Claims after amendment adequately supported by the original disclosure"
"Remittal to the department of first instance for further prosecution"

Decisions cited:
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Catchword:

-

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Case Number: T 0886/95 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 22 March 2000

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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 19 May 1995 refusing European patent application No. 90 913 758.0 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: P. A. M. Lançon
Members: G. F. E. Rampold
C. Rennie-Smith

Summary of Facts and Submissions

I. European patent application No. 90 913 758.0 filed on 10 September 1990 and published as WO 91/03949 on 4 April 1991 (European publication No. 0 491 791) was refused under Article 97(1) EPC by the decision of the Examining Division dated 19 May 1995. The decision was based on claims 1 to 33 filed on 3 February 1995. The stated ground of refusal was non-compliance of claims 1 to 5 and 15 to 33 as amended in the course of the first instance examination proceedings with the provisions of Article 123(2) EPC.

II. The International application as published under the PCT (WO 91/03949) contained three independent method (process) claims 1, 12 and 19, each followed by dependent claims. Claim 21 was directed to an "Apparatus for eliminating fat from a formed ground meat product" and was also followed by dependent claims.

The broadest independent method (process) claim 12 read as follows:

"A method for eliminating fat from a hamburger patty, while maintaining the structural integrity and texture of the hamburger, comprising the steps of:

(a) heating the hamburger patty to a temperature at which a portion of the fat contained in the hamburger is liquefied;

(b) applying pressure to the hamburger only after a portion of the fat contained in the hamburger has

been liquefied and while the fat remains liquefied, the pressure being sufficient to cause a substantial portion of the fat initially contained in the hamburger to be exuded therefrom, but low enough to retain the structural integrity and texture of the hamburger;

(c) introducing a heated, substantially non-fat liquid into the hamburger during at least a portion of the pressing step (b); and

(d) removing the liquefied fat and added liquid as they are exuded."

Dependent claim 13 was worded as follows:

"A method as defined in claim 12 wherein the pressing step (b) is a rolling pressure caused by a series of rollers which repeatedly traverse the hamburger in a parallel plane and on a circular path across the hamburger."

III. Those claims were amended in the course of the first instance examination proceedings so as to contain only one independent method (process) claim followed by dependent claims and one independent apparatus claim 15 also followed by dependent claims. Claims 1 to 5 were worded as follows:

"1. "A method for eliminating fat from a **ground meat** patty, while maintaining the structural integrity and texture of the **patty**, comprising the steps of:

(a) heating the **patty** to a temperature at which a

portion of the fat contained in the **patty** is liquefied,

(b) **repeatedly** applying pressure to the **patty** only after a portion of the fat contained in the **patty** has been liquefied and while the fat remains liquefied, the pressure being sufficient to cause a substantial of the fat initially contained in the **patty** to be exuded therefrom, but low enough to retain the structural integrity and texture of the **patty**,

(c) introducing a heated, substantially non-fat liquid into the **patty** during at least a portion of the pressing step, and

(d) removing the liquefied fat and added liquid exuded **from the patty**.

2. A method as defined in claim 1, wherein the patty is positioned on a support surface configured to facilitate removal of fat and liquid therefrom.

3. A method as defined in claim 1 or 2, wherein pressure is repeatedly applied to the patty by causing a rolling pressure to repeatedly traverse the patty in a direction parallel to a surface of the patty.

4. A method as defined in claim 3, wherein pressure is applied by causing a series of rollers to repeatedly traverse the patty surface.

5. A method as defined in claim 3 or 4, wherein the

or each roller traverses a circular path across the patty."

Dependent claims 6 to 14 related to further specific elaborations of the method according to claim 1.

IV. The examining division considered in its decision the amendment of the feature "hamburger" in claim 1 so as to read "ground meat patty" to be adequately supported by the disclosure on page 5, lines 32 to 36, in the context of the disclosure of the claimed invention as a whole.

It held, however, that the feature **"repeatedly** applying pressure to the patty" in pressing step (b) of claim 1 as amended involved the repeated use of any kind of pressure and represented accordingly a broadening of the claims beyond what had been included in the application as published, because the original disclosure in claim 13 of the published application referred to this particular feature only in association with the use of "rolling pressure caused by a series of rollers".

As to claim 2, the examining division concluded that the technical feature in question ("the patty is positioned on a support surface configured to facilitate removal of fat and liquid therefrom") was disclosed in claim 19 as published only in the combination of various other essential technical features, more specifically a 50% fat removal limit, and held that the particular feature of claim 2 taken in isolation from the original disclosure was not part of the invention as disclosed.

Concerning claims 3 to 5, the examining division referred to claim 13 of the application as published as the basis of the above-mentioned dependent claims and considered the various technical features in claim 13 to be so closely associated with each other that their combination was necessary to produce the result sought in the application. It was therefore of the opinion that claiming these features individually in separate dependent claims contravened Article 123(2) EPC.

Dependent claims 6 to 14 were considered by the examining division acceptable under the terms of Article 123(2) EPC.

Referring to claims 15 to 33 directed to an apparatus for eliminating fat from a ground meat patty, the examining division merely stated in general terms that the objections raised to claims 1 to 5 "applied *mutatis-mutandis* to claims 15 to 33".

V. An appeal was filed against the decision of the examining division. Following a communication from the board, the appellant filed on 27 October 1999 twenty complete sets of claims (a main request and nineteen auxiliary requests) for consideration by the board.

VI. In a telephone conversation on 26 January 2000 the appellant's representative was informed that the board could find no adequate support for the feature **"smooth** rolling surface", which was present in claim 24 of the main request and equally in the corresponding claims of all auxiliary requests 1 to 19, and likewise no support for the language "about 50% of its cooked, **precompressed** thickness" used in claim 25 of the main

request and similarly in the corresponding claims of all auxiliary requests 1 to 19.

VII. By a fax received on 29 February 2000, the appellant submitted an amended set of claims of which claims 1 to 23 and 26 to 33 were identical to those in the main request filed on 27 October 1999 and claims 24 and 25 were amended so as to read:

"24. An apparatus as defined in claim 22 or 23 , wherein the or each roller has a **non-stick** surface.

25. An apparatus as defined in any of claims 22 to 24, wherein the or each roller and the support surface are spatially offset such that a patty mounted on the top surface is compressed to less than about 50% of its cooked, **non-processed** thickness."

VIII. The appellant requests as the **main request** that the impugned decision be set aside and a patent be granted on the basis of claims 1 to 33 filed on 29 February 2000, or alternatively on the basis of one of the set of claims according to the auxiliary requests 1 to 19 filed on 27 October 1999.

Reasons for the Decision

The only issue to be decided by the board in the present case is whether or not the claims presently on file satisfy the requirements of Article 123(2) EPC. All references below to support for the present version of the claims in the originally filed documents are to

the international application as published under the PCT (WO 91/03949), unless otherwise specifically indicated.

Support of the present claims in the originally filed documents (Article 123(2) EPC):

1. The board concurs with the opinion of the examining division that the term **"ground meat patty"** for the product subjected to treatment by the method claimed in the present application is adequately supported by the disclosure in the description on page 5, lines 32 to 36 and, likewise, by the repeated references in the description and the claims to a "method and apparatus for eliminating fat from a formed ground meat product" (see, for example, page 4, lines 14 to 16; claims 1, 21).

As to the feature **"repeatedly** applying pressure to the patty" in the present version of claims 1 and 15, this is based, *inter alia*, on the statement at page 22, line 22 to page 23, line 23, which refers to pressure being applied to the patty **by different pressing techniques**, that is to say either **by a flat solid surface** (ie squeezing the patty between two flat surfaces) or **by a rolling device.**

In the context of the technique of applying pressure with a flat plate (see especially page 22, line 24 to page 23, line 5), express mention is made in the sentence bridging pages 22 and 23 to the fact that "this experiment [namely removal of fat from the patty by applying pressure with a flat plate, as described in

preceding lines 24 to 37 on page 22] was **repeated** at increasing forces". From this disclosure the skilled reader would, in the board's judgment, derive a method of carrying out the invention which comprises the steps of removing a first substantial portion of fat by applying pressure to the patty with a flat plate, releasing the applied force to remove and optionally recording the exuded fat quantity and then **reapplying pressure** at increasing forces to discharge more fat from the patty. This means in other words that pressure would **repeatedly** be applied to the patty.

The alternative technique of repeatedly applying pressure to the patty by a rolling device (rolling pressure) is based, *inter alia,* on the disclosure in the description on page 4, lines 22 to 24 ("by applying a rolling pressure which **repeatedly** traverses the product"), page 4, lines 35 to 36 ("is subject to a **periodic rolling compressive pressure**") and on the actual demonstration of the claimed invention in example 1 (see especially page 19, lines 5 to 7: "The cylindrical drum is rolled across the hamburger patty **five times**").

2. The technical feature of new dependent claims 2 and 16 is based on the disclosure in the description on page 22, lines 10 to 13, referring to "the heated hamburger being placed on a surface designed to both support it and facilitate the immediate separation of any fat exuded during pressure application"; a similar disclosure in dependent claim 9 which adds to independent claim 1 the feature that the product is compressed in step (b) "by placing the product on a

support surface which facilitates the removal of fat away from the product"; and the reference in claim 21 to an apparatus "comprising a support member for supporting the product and configured to promote the flow of fat away from the product".

As none of the above-mentioned disclosures makes specific mention of a particular proportion of the fat being removed, the board cannot share the opinion of the examining division that a 50% limit to the weight of fat removed should be introduced into claim 2, so as to comply with the requirements of Article 123(2) EPC.

3. Claim 3 in the present version relies on the references in claim 1, step (b) and in the description on page 4, lines 22 to 24, to "applying a rolling pressure which repeatedly traverses the product in a plane parallel to the support member". No mention is made in these references to either the use of rollers or a circular path.

4. The feature in the present version of claim 4 is based on claim 13 and the various references to the use of a plurality of rollers, for example, on page 6, lines 35 to 36 ("The cone rollers are mounted so that a linear generatrix of each roller is parallel to the top surface of the product"); page 8, lines 20 to 24 ("both set of rollers are configured and orientated such that their axes intersect the vertical axis of the circular path at, or close to, the plane of the top surface of the meat product being treated"); and page 15, lines 33 to 34 ("use is made of four cone rollers").

5. With regard to the feature in the present version of

claim 5 ("the or each roller traverses a circular path across the patty") it is noted that, for example, claims 6 and 8 contain a reference to step (b) of compressing being carried out "by causing the rolling pressure to travel on a circular path across the product". Moreover, the description states on page 12 lines 27 to 29: "Thus, the rollers 20 and 22 roll upon the top surface of the hamburger patty applying a compressive pressure while following a circular path about the central axis of the wall".

6. The board concurs with the statement of the examining division in the impugned decision (see "Facts and submissions", item 5, point 3) that "claims 6 to 14 can be regarded as meeting the requirements of Article 123(2) EPC under the proviso that the claims to which they refer can be regarded as being allowable under Article 123(2) EPC". From the foregoing points it is clear that the proviso referred to by the examining division is met in the present case.

7. Apparatus claims 15 and 16 in the present version are the counterpart of present method claims 1 and 2. As to the support of the particular features **"ground meat patty"** and **"repeatedly** applying pressure to the patty" in present claim 15, as well as the feature of present claim 16, reference is made to the statements in points 1 and 2 above, which apply equally to the present version of claims 15 and 16.

8. As to the feature of present claim 17, this is based on the repeated references in the description to the use of a perforated plate as the support member for the meat patty (see page 11, line 6, in the context of

Figure 1; page 22, line 21; page 23, lines 27 and 34 in the context of Figure 4).

9. The feature of present claim 18 is derived from claim 23 and that of present claim 19 from claim 24.

10. The feature of present claim 20 is based, for example, on the disclosure in the description on page 22, lines 21 to 23 ("The hamburgers were pressed at various applied pressures according to the following techniques"), as well as on the references in the paragraph bridging pages 25 and 26 to "various applied compression forces" and "several different experiments were repeated at increasing applied forces" in the context of Figure 5.

11. Present claim 21 is based on the statements on page 17, lines 5 to 26, which provide and illustrate by the indication of specific pressure levels at different stages of the pressing step the teaching that the supply of non-fat liquid to the top of the surface is continued for a period of time after the compressive force has been substantially decreased.

12. The feature of present claim 22 refers to the type of apparatus equipped with a cylindrical drum ("at least one roller") which is repeatedly rolled across the patty to discharge fat from it (see the paragraph bridging pages 18 and 19; Example 2, line 9).

13. As to the support for the feature in present claim 23 see point 4 (above).

14. Present claim 24 is based on the reference on page 8,

lines 29 to 30 to the roller surfaces being provided "with a non-stick coating".

15. The feature of present claim 25 is based on the disclosure in the description on page 28, lines 6 to 12.

16. The feature of present claim 26 is derived from the disclosure in the description on page 7, lines 1 to 2.

17. The feature of present claim 27 refers to the disclosure in the sentence bridging pages 6 and 7.

18. The feature of present claim 28 is supported by claims 26 and 33 and follows, moreover, from the disclosure in the description on page 7, lines 14 to 19.

19. The feature of present claim 29 is supported by a number of references in the description to "cone rollers", "conical roller system" (see, for example, page, lines 27, 31; page 7, line 30, Figure 1).

20. The feature of present claim 30 refers to the technical teaching provided on page 7, lines 1 to 4.

21. Present claim 31 is based on claim 32 and follows, moreover, from the disclosure on page 15, line 30 to page 16, line 14 and Figure 1

22. The "maximum diameter of the or each roller" specified in present claim 32 and the "pressure applied by the or each roller in the range of 6 to 9 pounds per square inch" specified in present claim 33 is based on the

disclosure on page 28, lines 22 to 24.

Conclusion

The amendments which have been incorporated in the claims of the main request are not such that the application contains subject-matter which extends beyond the content of the application as filed. All claims are therefore considered acceptable as being adequately supported by the original disclosure and comply in this formal respect with Article 123(2) EPC.

Since the main request is considered acceptable under the terms of Article 123(2) EPC, there is, at this stage, no need to deal with the auxiliary requests.

Remittal to the department of first instance (Article 111(1) EPC):

In accordance with decisions G 9/91 and G 10/91 (OJ EPO 1993, 408 and 420, see in particular reasons, point 18) the essential function of an appeal is to consider, whether the decision which has been issued by the first instance department is correct. Hence, a case is normally referred back if essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided by the department of first instance.

In particular, remittal is taken into consideration by the boards in cases where a first instance department issues a decision solely upon one particular issue which is decisive for the case against a party and leaves other essential issues outstanding.

Those observations apply fully to the present case. The examining division decided that claims 1 to 5 and 15 to 33 as amended before grant did not satisfy the requirements of Article 123(2) EPC, but left other essential issues, for example novelty and inventive step (Articles 52(1), 54, 56 EPC), undecided.

Thus, in the circumstances of the present case, it is justified and even necessary to remit the case to the examining division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution.

The Registrar: The Chairman:

M. Dainese P. A. M. Lançon